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Gilles Rubinstenn

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EXAMINER

BORISSOV, IGOR N

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3628

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/024,351	Applicant(s) RUBINSTENN ET AL.	
	Examiner Igor N. Borissov	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Amendment received on 04/05/2007 is acknowledged and entered. New claims 31-34 have been added. Claims 1-34 are currently pending in the application.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-19 and 24-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In determining whether the claimed subject matter is statutory under 35 U.S.C. 101, a practical application test should be conducted to determine whether a “useful, concrete and tangible result” is accomplished. See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998).

An invention, which is eligible or patenting under 35 U.S.C. 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “useful, concrete and tangible result”. The test for practical application as applied by the examiner involves the determination of the following factors”

(a) “Useful” – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.
- ii. if the utility is not asserted in the written description, then it must be well established.

(b) “Tangible” – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) “Concrete” – Another consideration is whether the invention produces a “concrete” result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

35 U.S.C. § 101 provides:

Whoever invents or discovers any new and useful **process, machine, manufacture, or composition of matter**, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Traditional process can be understood as either transforming subject matter or implemented by one of the other three categories. See *Tilghman v. Proctor*, 102 U.S. 707, 722 (1880) (“where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes, methods, or operations are called processes.”); see also *AT&T*, 172 F.3d at 1356, 50 USPQ2d at 1450 (“any step-by-step process, be it electronic, chemical, or mechanical, involves an ‘algorithm’ in the broad sense of the term.”).

Method claim 1 does not recite any electrical, chemical, or mechanical acts or results, typical in traditional process claims; the claim does not require any machine or apparatus to perform the recited steps; and, finally, the claim does not provide any physical transformation of an article to a different state or thing, nor does it require any transformation of data or signals. However, "...a process claim [in] compliance with Section 101 requires some kind of transformation or reduction of subject matter." See *In re Schrader*, 22 F.3d 295, 30 USPQ2d at 1459.

Furthermore, the claim does not provide any indication who or what is performing the steps of: "*asking a subject personal questions*"; "*receiving answers to the personal questions*"; "*selecting at least one customized set*" and "*informing the subject about said set*". Accordingly, the claim is so broad that it is directed to the abstract idea itself, rather than its practical implementation.

So as the claim 1 is directed to the abstract idea itself, does not require any machine or apparatus to perform the recited steps, and does not require implementing a mathematical formula or algorithm to transform data, the information recited in the claim does not represent a real world activity such as found in *Arrhythmia*, *Alappat*, or *State Street*. As such, claim 1 falls outside the scope of § 101 as failing to apply its abstract idea to produce a useful and concrete and tangible result.

Same reasoning applied to other independent method claims. As per system claim 11, the recited *means* for enabling the recited functionalities could be understood as merely software or code per se, which is not statutory subject matter.

The remaining dependent claims do not cure § 101 deficiencies. Accordingly, Claims 1-19 and 24-30 are rejected as being directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney et al. (WO 01/18674 A2) in view of Otworth et al. (US 2002/0059030 A1).

Maloney et al. (hereinafter Maloney) teaches a method, system and computer-readable medium for providing a customized product combination to a consumer, comprising:

Independent Claims

Claims 1, 11 and 20.

Asking a subject personal questions on at least one topic including characteristics of at least one external body condition of the subject (page 11, lines 26-30);

receiving answers to the personal questions (page 11, lines 26-27);

providing the subject with at least one set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject (page 11, lines 7-9), said "providing" step suggests a step of *selecting* of said *at least one* set of testing material;

informing the subject about said at least one set of testing material (page 11, lines 13-14).

While Maloney teaches selecting said at least one set of testing material, Maloney does not specifically teach that said set is selected *based on the received*

answers; that said set of testing material is a *customized* set; and that said customized set is selected from a *plurality* of testing materials.

Otworth et al. teaches a method and system for analysis of remotely collected biological samples, and includes: *based upon collected historical data* related to a subject, providing the subject with a *customized* kit for collecting the biological sample from the subject, wherein said kit includes at least one replaceable cartridge which is determined/selected based on the tests determined to be conducted on the subject (*plurality* feature) [0043]; [0040].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said set is selected *based on the received answers*; that said set of testing material is a *customized* set; and that said customized set is selected from a *plurality* of testing materials, as disclosed in Otworth et al., because it would advantageously allow to accommodate said various profile sub-categories of consumers, thereby providing each customer with said customized test kit (Maloney; page 11, lines 6-10). Furthermore, so as this is a case where the improvements are no more than the predictable use of prior art elements according to their established functions, no further analysis for “motivation to combine” is required by the Examiner. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Claim 24. Maloney teaches:

Asking a subject personal questions on at least one topic including characteristics of at least one external body condition of the subject (page 11, lines 26-30);

receiving answers to the personal questions (page 11, lines 26-27);

providing the subject with at least one set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject (page 11, lines 7-9), said “providing” step indicates a step of *selecting* of said at least one customized set of testing material;

providing the subject with the set of testing material (page 11, lines 13-14);

ascertaining quantitative information by collecting data derived from use of the testing material on the subject (page 11, lines 15-16, 19-20);

recommending at least one beauty product to the subject based on the received answers and the ascertained quantitative information (page 12, lines 27-33).

While Maloney teaches selecting said at least one set of testing material, Maloney does not specifically teach that said set is selected *based on the received answers*; that said set of testing material is a *customized* set; and that said customized set is selected from a *plurality* of testing materials.

Otworth et al. teaches a method and system for analysis of remotely collected biological samples, and includes: *based upon collected historical data* related to a subject, providing the subject with a *customized* kit for collecting the biological sample from the subject, wherein said kit includes at least one replaceable cartridge which is determined/selected based on the tests determined to be conducted on the subject (*plurality* feature) [0043]; [0040].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said set is selected *based on the received answers*; that said set of testing material is a *customized* set; and that said customized set is selected from a *plurality* of testing materials, as disclosed in Otworth et al., because it would advantageously allow to accommodate said various profile sub-categories of consumers, thereby providing each customer with said customized test kit (Maloney; page 11, lines 6-10). Furthermore, so as this is a case where the improvements are no more than the predictable use of prior art elements according to their established functions, no further analysis for “motivation to combine” is required by the Examiner. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Claim 25. Maloney teaches:

receiving information regarding at least one external body condition of a subject (page 11, lines 26-30);

providing the subject with at least one set of testing material for determining quantitative information that would aid in recommending at least one beauty product to

the subject (page 11, lines 7-9), said “providing” step suggests a step of *selecting* of said at least one set of testing material;

informing the subject about said at least one set of testing material (page 11, lines 13-14).

While Maloney teaches selecting said at least one set of testing material, Maloney does not specifically teach that said set is selected *based on the received answers*; that said set of testing material is a *customized* set; and that said customized set is selected from a *plurality* of testing materials.

Otworth et al. teaches a method and system for analysis of remotely collected biological samples, and includes: *based upon collected historical data* related to a subject, providing the subject with a *customized* kit for collecting the biological sample from the subject, wherein said kit includes at least one replaceable cartridge which is determined/selected based on the tests determined to be conducted on the subject (*plurality* feature) [0043]; [0040].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said set is selected *based on the received answers*; that said set of testing material is a *customized* set; and that said customized set is selected from a *plurality* of testing materials, as disclosed in Otworth et al., because it would advantageously allow to accommodate said various profile sub-categories of consumers, thereby providing each customer with said customized test kit (Maloney; page 11, lines 6-10). Furthermore, so as this is a case where the improvements are no more than the predictable use of prior art elements according to their established functions, no further analysis for “motivation to combine” is required by the Examiner. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Dependent Claims

Claim 2. See reasoning applied to claim 1.

Claim 3. See reasoning applied to claim 1.

Claim 4. Maloney teaches: ascertaining quantitative information by collecting data derived from use of the testing material on the subject (page 11, lines 15-16, 19-20).

Claim 5. Maloney teaches: recommending at least one beauty product to the subject based on the received answers and the ascertained quantitative information (page 12, lines 27-33).

Claim 6. Maloney teaches that the customized set of testing material includes at least one of a pH indicator, sebutape, and a corneodisque indicator (page 11, lines 11-12).

Claim 7. Maloney teaches that the questions are posed to the subject over a computer network (page 8, line 35 – page 9, line 2), and wherein the at least one customized set of testing material is delivered to the subject via a courier (column 11, line 18).

Claim 8. Maloney teaches selecting and shipping an appropriate (customized) set to a customer (page 11, lines 7-9 and 18). Furthermore, Maloney teaches profiling a consumer based on consumer's physiological preferences and physiological conditions, said conditions including skin type and life stage, said profiling further includes assigning the consumer to various profile sub-categories which correspond to specific beauty product categories (page 6, line 32 – page 7, line 12), thereby suggesting that said selected (customized) set is readily available for each consumer in each of said profile sub-categories. Otworth et al. teaches that said kit includes at least one replaceable cartridge which is determined/selected based on the tests determined to be conducted on the subject [0043] (see reasoning applied to Claim 1), thereby suggesting *maintaining an inventory of a plurality of differing groups of customized sets of testing material, each group containing a combination of testing material different from a combination in another group*. The motivation to combine the references would be advantageously allowing to accommodate said various profile sub-categories of consumers, thereby providing each customer with said test kit (page 11, lines 6-10).

Claim 9. See reasoning applied to claim 2.

Claim 10. See reasoning applied to claim 2.

Claim 12. See reasoning applied to claim 2.

Claim 13. See reasoning applied to claim 4.

Claim 14. See reasoning applied to claim 5.

Claim 15. See reasoning applied to claim 6.

Claim 16. See reasoning applied to claim 7.

Claim 17. See reasoning applied to claim 8.

Claim 18. See reasoning applied to claim 9.

Claim 19. See reasoning applied to claim 10.

Claim 21. See reasoning applied to claim 2.

Claim 22. See reasoning applied to claim 4.

Claim 23. See reasoning applied to claim 5.

Claim 26. Said method, wherein the information is chosen from answers to questions and at least one representation of the external body condition (image of the subject) (page 11, lines 26-30; page 20, lines 27-34).

Claim 27. Said method, wherein the information is an image of the external body condition (page 20, lines 27-34).

Claim 28. See reasoning applied to claim 16.

Claim 29. See reasoning applied to claim 2.

Claim 30. See reasoning applied to claim 6.

Claims 31-34. See reasoning applied to the independent claims.

Response to Arguments

Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Igor N. Borissov/

Primary Examiner, Art Unit 3628

03/16/2008